

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/047,607 Confirmation No.: 5741
Applicant: Andrew C. Gilbert, et al.
Title: ELECTRONIC TRADING FOR PRINCIPAL/BROKER TRADING
Filed: January 14, 2002
Art Unit: 3691
Examiner: Muriel Tinkler

Atty. Docket: 01-1034
Customer No. 63710

REQUEST FOR COMPLETION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office to errors in the Office's paper of February 28, 2008, and requests (a) that the Office reissue the paper in corrected and completed form, and (b) reset the period for reply to one month from the date of the reissued Office paper.

MPEP § 710.06 was recently amended to provide an appropriate incentive for an examiner to do complete work the first time, because an applicant now has the authority to return defective work product and require that it be redone, with no advancement toward final rejection. Section 710.06 reads as follows, in relevant part:

710.06 Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action ... the Office will set a new period for reply, if requested to do so by the applicant... The new period for reply must be at least 1 month and would run from the date the error is corrected....

...

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

Many of the below queries arise under 37 C.F.R. § 1.104(c)(2), which reads as follows, in relevant part:

§ 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

That is, in situations where the reference discloses anything more than or in addition to the invention claimed, as here, Rule 1.104 requires an Office Action must do two things:

(i) “designate” portions as nearly as practicable, and (ii) “clearly explain” the pertinence. MPEP § 710.06 and Rule 104 requires that the Examiner prepare a corrected Office Action that answers each of the following questions by both “designating” a portion of a reference, and if that portion discusses more than one thing that could correspond to the claim language, specifically identifying one particular one of the things, *e.g.*, by name or reference numeral.

Kindly provide a corrected Action that addresses all of the following issues, or allows the relevant claims:

1. Paragraphs 2, 3 and 4. The Office Action is internally inconsistent, and Applicant cannot discern what the issues currently pending, and therefore cannot reply.
 - (a) Paragraph 2 of the Office Action demands a terminal disclaimer. What is the basis for requiring a terminal disclaimer?
 - (b) Is there a double patenting rejection pending or not? If so, over what other patent?
 - (c) If any double patenting rejection is pending, what one claim of this application is an obvious variant of what one claim of the prior patent? MPEP § 804(B)(1) requires that two claims be specifically identified and compared. This Office Action does not do so. The failure to state a complete rejection affects Applicant’s ability to reply.
 - (d) The reason that Applicant “has not pointed out which claim ... they are referring to” is because the prior Office Actions have not designated particular claims that are thought to raise a problem. An applicant cannot “point out” disagreements with positions that an examiner does not state clearly under recognizable principles of law.

- (e) If there is any double patenting rejection pending, a number of other grounds of traverse were stated at pages 11-12 of Applicant's Reply of November 2007. The Office Action of February 2008 fails to "Answer All Material Traversed." The Action's silence affects Applicant's ability to reply.
2. Paragraph 5 raises a "new matter" objection to amended claims. However, MPEP § 706.03(o), particularly Form Paragraph 7.28 Note 3, instructs that this is not proper examination procedure. The courts have made clear that there is no such thing as a "new matter" rejection for a claim amendment. *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ2d 323, 326 (CCPA 1981) ("The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure [is] not § 132," emphasis added). This breach of examination procedure affects Applicant's ability to reply. A new Office Action is required.
 3. Paragraph 8 is directed to a mish-mash of "enablement" and "new matter," but does not use any of the form paragraphs authorized in the MPEP, but instead uses language improvised by the Examiner. The office Action improvises a new doctrine of law out, but omits consideration of a number of essential issues. Without discussion of those issues, Applicant is unable to reply.

MPEP § 706.03(c), in note 3 to form paragraphs 7.31.02, requires that an "enablement" rejection discuss the *Wands* factors, and requires the Examiner to comply with MPEP §§ 2164.01(a) and 2164.04. MPEP § 2164.04 reads as follows, in pertinent part (citations and quotations omitted):

2164.04 Burden on the Examiner Under the Enablement Requirement

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. ... A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. ... As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure."

... the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

[T]he analysis and conclusion of a lack of enablement are based on the [*Wands*] factors discussed in MPEP § 2164.01(a) and the evidence as a whole... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the

claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

The test for “enablement” is “undue experimentation.” *In re Wands*, 858 F.3d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *Id.* The enablement requirement may be met by the knowledge in the art, even if it is not in the specification or incorporated by reference. *Falkner v. Inglis*, 448 F.3d 1357, 1365, 79 USPQ2d 1001, 1006 (Fed. Cir. 2006). “[A] patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.” *Koito Mfg. Co. v. Turn-Key Tech LLC*, 381 F.3d 1142, 1156, 72 USPQ2d 1190, 1200 (Fed. Cir. 2004).

- (a) Is paragraph 8 of the Action based on an authorized form paragraph? If Applicant has overlooked it, Applicant apologizes. If not, does the Examiner have authority to invent new form paragraphs? If so, please identify the document that gives the Examiner that authority. If both questions are answered no, the Office Action must be withdrawn, and reissued in corrected form.
 - (b) There is nothing in the Office Action that appears to “give reasons for the uncertainty of the enablement” as required by MPEP § 2164.04. Without that showing, Applicant is unable to reply.
 - (c) The Office Action is silent on “undue experimentation.” Because the Action gives no insight into the Examiner’s thoughts on any relevant issue, Applicant is unable to reply.
 - (d) The law is clear that the mere fact that language “is not supported by the specification” is not grounds for an enablement rejection. If the Examiner disagrees with the Federal Circuit’s *Falkner* and *Koito* decisions, Applicant requests a document having force of law that states whatever principle of law the Examiner believes to apply.
- 4. Paragraph 12 does not indicate any portion of Silverman ’583 thought to correspond to the “special designation” of claims 1 and 9. This failure to address the claim language affects Applicant’s ability to reply.
 - 5. Paragraph 12 raises a § 102 rejection based on two disparate and disconnected parts of Silverman ’583. Some portions of claims 1 and 9 are compared to the Background of Silverman ’583, which is to say, embodiments that are not the subject of Silverman’s “detailed Description,” and some portions are compared to Fig. 1 and to col. 4, which are part of Silverman’s “Detailed Description” of his advance over the Background.

MPEP § 2131 elaborates on an Office Action's duties under § 102:

2131 Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim.

How are the two disparate parts of Silverman '583 interrelated as in the claims?

6. Paragraph 16 asserts that "Silverman '583 discloses the invention in Claims [3] See the rejections of Claims 1 and 9 above." However, claim 3 recites "determining whether the first trader is acting as a broker" and "preventing the second trader from acting on the trading command when the first trader is acting as a broker" and this language is not in claims 1 and 9. It appears that there is no element-by-element comparison of this language of claim 3 to any reference. If there is a comparison, kindly identify it. If not, please provide it. In either case, the Office Action fails to "designate portions relied on" and "explain the pertinence" of the references to the claims, as required by 37 C.F.R. § 1.104(c)(2). These two oversights affect Applicant's ability to reply.
7. Paragraph 16 asserts that "Silverman '583 discloses the invention in Claims [8] See the rejections of Claims 1 and 9 above." However, claim 8 recites "imposing the trading limitations on a broker trader acting on behalf of the principal trader." This language is not in claims 1 and 9. It appears that there is no element-by-element comparison of this language of claim 8 to any reference.
8. Paragraph 16. Does the Examiner recognize that the word "broker" is an established term of art, defined by law in most contexts, and that the definition for "broker" is not synonymous with "trader?" Does the Office Action equate the two? If so, on what basis? If not, how is the discussion of claim 3 relevant to the claims and to Silverman '583? Because the Office Action fails to "clearly explain" the pertinence of Silverman '583, it violates 37 C.F.R. § 1.104(c)(2), and that affects Applicant's ability to reply.
9. Paragraph 16. The Office Action fails to even mention how Silverman '583 is relevant to the claim language "when the first trader is acting as a broker" or otherwise conditioning action of the system on the nature of a party, as opposed to the financial condition of a party. How is Silverman '583 relevant to this particular claim language?
10. Paragraph 16. MPEP §§ 2142 and 2143.03 require a *prima facie* discussion of "reasonable expectation of success" of the particular modification proposed for all obviousness rejections. This is omitted from the Office Action. This omission affects Applicant's ability to reply.
11. In the Information Disclosure Statement and Form 1449, the reference "Sequor Group Inc., MoneyMatch Functional Specification (August 1990)" is crossed off without consideration. This reference is in the IFW as an "NPL Document" filed November 9,

2007, of 87 pages. Because this reference was not considered, the Action of February 2008 is incomplete on its face, and must be redone.

Applicant requests a corrected Office Action, and if no such Action can be prepared, that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1034.

Respectfully submitted,

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Dated: May 28, 2008

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